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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,383	06/13/2005	Peter Horlacher	C 2754 PCT/US	5031
23657	7590	07/05/2007	EXAMINER	
COGNIS CORPORATION			CARR, DEBORAH D	
PATENT DEPARTMENT			ART UNIT	PAPER NUMBER
300 BROOKSIDE AVENUE			1621	
AMBLER, PA 19002				
MAIL DATE		DELIVERY MODE		
07/05/2007		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/538,383	HORLACHER ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Deborah D. Carr	1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 10 April 2007.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 4-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 4-14 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments filed 10 April 2007 have been fully considered but they are not persuasive. The rejection of claims 4-10 under 35 USC§103 is maintained. Newly added claims 11-14 are being added to the 103 rejection of record.
2. Applicant's arguments, see page 4, filed 10 April 2007, with respect to claim 4, 8-10 have been fully considered and are persuasive. The rejections under 35 USC§102(e) & 35 USC§112 of claims 4, 8-10 has been withdrawn.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 4-14 rejected under 35 U.S.C. 103(a) as being unpatentable over Saebo et al. (US Pat. 6,743,931) in view of Reaney et al. (US Pat. 6,420,577).

US'931 discloses a process of preparing conjugated linoleic acids via isomerization, saponification then followed by distillation. Additionally the reaction can be conducted at

temperatures that range between 100°C and 130°C, see columns 9 & 10. The claims differ from the reference by including a crystallization step after saponification.

However it would have been obvious to one of ordinary skill in the art at the time the invention was made to added crystallization as a purification step after saponification. It is conventionally known as shown in US'577 that crystallization preceded by distillation and crystallization alone would have been an obvious modification.

Applicants have argued the following:

According to the Examiner, the claims differ from the primary reference, Saebo, by "including a crystallization step after saponification." The Examiner further states that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to added [sic] crystallization as a purification step after saponification." Thus, the Examiner cites the teachings of Reaney for the addition of crystallization after saponification as a =conventionally known" modification.

The rejection is respectfully traversed. For the following reasons, it is submitted that the combination of the teachings of Saebo and Reaney is improper under the law. Saebo, the primary reference of the rejection, discredits the teachings of Reaney, the secondary reference, to the extent that there would be no motivation to the person having ordinary skill in the art ("PHOSITA") to combine the references in the manner suggested by the Examiner.

Response to 103 arguments:

Arguments regarding Reaney having been applied inappropriately are not found to be convincing. The examiner is referred to Saebo (US'931) col. 8, lines 6-30 to discredit Reaney as a viable reference based on the phrase "older isomerization processes."

The patents Saebo refer to were issued during the years ranging 1941-1983. Reaney was issued prior to Saebo and not mentioned; therefore, it is obvious this patent is not considered one of the "older isomerization processes."

How the isomerization process resulting in the isomerized reaction product is not of importance since Reaney and Saebo both produce conjugated linoleic acids. It should be noted Reaney was applied to support the premise that it is conventionally known in the art to add crystallization as a purification step after saponification. To argue the secondary reference in a means other than it was originally applied to negate the primary reference does not overcome the rejection or address the issues at hand.

Does or doesn't Reaney support the premise that it is conventionally known in the art to add crystallization as a purification step after saponification? Reaney does support this premise and one of ordinary skill in the art would conventionally apply a crystallization step to remove impurities produced in the saponification step.

### *Conclusion*

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah D. Carr whose telephone number is 571-272-0637. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or

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access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or  
571-272-1000.



DEBORAH D. CARR  
PRIMARY EXAMINER

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